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10/618,562	07/11/2003	Edward Kirk	1776/40366 PA3 TMM	5160

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EXAMINER

GERRITY, STEPHEN FRANCIS

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/618,562	Applicant(s) KIRK ET AL. cd	
	Examiner Stephen F. Gerrity	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/11/03</u> . | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Information Disclosure Statement

1. Receipt is acknowledged of an Information Disclosure Statement, filed 11 July 2003, which has been placed of record in the file. An initialed, signed and dated copy of the PTO-1449 form is attached to this Office action.

Drawings

2. The drawings are objected to because
- a. the numbers are rough and blurry;
 - b. orienter 216 is not shown -- see page 6, line 13;
 - c. air supply 274 is not shown -- see page 6, lines 13 and 14;
 - d. roller tray 32 is not shown -- see page 6, line 20;
 - e. break ring 14 is not shown -- see page 7, lines 11 and 12, it is possible that the use of the number 14 is incorrect and that the break ring is labeled as 40;
 - f. rod 148d is not shown -- see page 8, line 20;
 - g. first prox switch 240 is not shown -- see page 10, line 17;
 - h. second prox switch 242 is not shown -- see page 10, line 18;

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- i. punch holder and punch -- mentioned on page 12, lines 10 and 11 are not shown or labeled;
- j. in figure 1, the numbers 34 and 36 are shown, but they are not described in the written description; and
- k. in figure 3, the number 13 is shown, but it is not described in the written description.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title of the invention should be amended to be consistent with the claimed invention, which is both an apparatus and a method.

4. The disclosure is objected to because of the following informalities:

- a. at page 4, line 22, "correction" should be --correct--
;
- b. the term "break ring" should perhaps be changed to --brake ring-- see at least page 7, line 11;
- c. the numbers 14 and 40 are each used for the break ring
-- see at least page 7, lines 11 and 12;
- d. at page 8, line 19, the number 134 is used for the moving iris plate cylinder, but at page 9, lines 3 and 4, the number 134 is also used for the moving iris separator cylinder;

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- e. at page 9, line 7, "138" should perhaps be changed to --134--;
- f. the punch holder and punch mentioned on page 12, lines 10 and 11 are not described adequately;
- g. at page 13, line 1, "96" should be changed to --260--;
- h. at page 13, line 14, the discussion of the orienter 216 and its function is not adequate because the orienter is not shown in the figures; and
- i. at page 14, line 11, the discussion of the prox switches and their function is not adequate because they are not shown in the figures.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 13-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected,

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to make and/or use the invention. The claims set forth that the netting is tighten around the material therein, and it is apparent from the written description that applicant intends for this to be done by the "moving iris plate". The written description sets forth that the moving iris plate is moved by a cylinder, but fails to adequately describe how such is accomplished. The disclosure is considered to be non-enabling because the figures and written description do not adequately show and describe how the moving iris plate is in fact moved to tighten the netting around the material within the netting. A person having ordinary skill in the art would be unable to make and use the claimed invention set forth in claims 13-25 for the reasoning set forth above. Appropriate correction and/or clarification is required. Applicant is reminded about the prohibition against the entry of new matter in the disclosure, see 35 U.S.C. 132(a).

Double Patenting

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1-25 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-26 of copending Application No. 10/787988. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The claims 1-25 are identical to claims 1-3 and 5-26 of copending application 10/787,988. For this reason, the claims are provisionally rejected under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Tipper et al. (US 3,389,533).

The Tipper et al. reference discloses an apparatus and method for enclosing material within netting (see col. 2, line 24) including a product tube (90), a clipper (106), a handle

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maker (117, 118) as seen in figure 10, and a knife (122). The material is enclosed within the netting by closing an end of the netting (with clip 107 for the first package -- see the discussion at col. 3, lines 68-75), placing material within the netting (see col. 2, lines 15-28), closing the netting (using another clip 107 for the second package), creating a loop (121) from the netting (by the use of posts 117 and 118) and severing the loop from the netting (using knife 122), and closing the loop (121) to create a handle on the netting enclosing the material. The closing of the loop (121) is done by attaching the loop (121) to the netting by the use of clip (108).

11. Claims 1, 4-6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsal (**FR 2,463,059**).

The Marsal reference discloses an apparatus and method for enclosing material within netting (see Derwent information attached to the reference) including a product tube (see figs.), a first clipper (108), a second clipper (109), a handle maker (116) as seen in figure 11, and a knife (110). The material is enclosed within the netting by closing an end of the netting (with clip 106 for the first package), placing material within the netting, closing the netting (using another clip 106 for the second package), creating a loop (114) from the netting (by the

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use of 116) and severing the loop from the netting (using knife 110), and closing the loop (114) to create a handle on the netting enclosing the material. The closing of the loop (114) is done by attaching the loop (114) to the netting by the use of clip (107) with the loop being attached after the netting is severed by the knife (110).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2, 3 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tipper et al. (US 3,389,533) in view of Niedecker (US 5,300,344) and Grip et al. (US 6,270,821).

The Tipper et al. reference meets all of applicant's claimed subject matter with the exception of (in the apparatus claims) a means for printing information on a label and a means for attaching the label to the netting, and a scale to measure a weight of the material and transmit the weight to the means for printing, and (in the method claims) inserting a label in the

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loop when closing the loop, weighing the material and printing a weight of the material on the label, and printing other information on the label.

The Niedecker reference discloses that it is old and well known in the relevant art to provide a means for printing (see col. 2, lines 65-68) information on a label and means for attaching (see col. 1, lines 8 and 9) the label to the netting, and a scale (see col. 1, line 19) to measure a weight of the material and transmit the weight to the means for printing (see col. 2, lines 65-68), and the Niedecker reference also discloses that it is old and well known in the relevant art to insert a label when closing the netting (see col. 1, lines 6-23), to weigh the material (col. 1, line 19) and print a weight of the material on the label (col. 1, line 14), and to print other information on the label (col. 1, line 14).

The Grip et al. reference discloses that it is old and well known in the relevant art to affix a pouch having a label thereon to the loop of the netted product with a clip, and with the label having the weight and other information applied thereto as seen in figures 8 and 9.

It would have been obvious to a person having ordinary skill in the art, at the time applicant's invention was made, to

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have modified the apparatus and method of Tipper et al. by having provided a means for printing information on a label and means for attaching the label to the netting, and a scale to measure a weight of the material and transmit the weight to the means for printing, and inserting a label in the loop when closing the loop, weighing the material and printing a weight of the material on the label, and printing other information on the label, as suggested by the teachings of Niedecker and Grip et al., for the self-evident advantage of providing the consumer with product information for regulatory and marketing reasons -- see col. 1 of Niedecker and col. 6 of Grip et al.

14. Claims 2, 3, 7-9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsal (FR 2,463,059) in view of Niedecker (US 5,300,344) and Grip et al. (US 6,270,821).

The Marsal reference meets all of applicant's claimed subject matter with the exception of (in the apparatus claims) a means for printing information on a label and a means for attaching the label to the netting, and a scale to measure a weight of the material and transmit the weight to the means for printing, and (in the method claims) inserting a label in the loop when closing the loop, weighing the material and printing a

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weight of the material on the label, and printing other information on the label.

The Niedecker reference discloses that it is old and well known in the relevant art to provide a means for printing (see col. 2, lines 65-68) information on a label and means for attaching (see col. 1, lines 8 and 9) the label to the netting, and a scale (see col. 1, line 19) to measure a weight of the material and transmit the weight to the means for printing (see col. 2, lines 65-68), and the Niedecker reference also discloses that it is old and well known in the relevant art to insert a label when closing the netting (see col. 1, lines 6-23), to weigh the material (col. 1, line 19) and print a weight of the material on the label (col. 1, line 14), and to print other information on the label (col. 1, line 14).

The Grip et al. reference discloses that it is old and well known in the relevant art to affix a pouch having a label thereon to the loop of the netted product with a clip, and with the label having the weight and other information applied thereto as seen in figures 8 and 9.

It would have been obvious to a person having ordinary skill in the art, at the time applicant's invention was made, to have modified the apparatus and method of Marsal by having

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provided a means for printing information on a label and means for attaching the label to the netting, a scale to measure a weight of the material and transmit the weight to the means for printing, and inserting a label in the loop when closing the loop, weighing the material and printing a weight of the material on the label, and printing other information on the label, as suggested by the teachings of Niedecker and Grip et al., for the self-evident advantage of providing the consumer with product information for regulatory and marketing reasons -- see col. 1 of Niedecker and col. 6 of Grip et al.

15. Claims 1, 4-6, 10, 13, 14, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over May et al. (US 5,165,216) in view of Marsal (FR 2,463,059).

The May et al. reference discloses an apparatus and method for enclosing material within netting (see col. 3, line 40), a first clipper (16), a second clipper (18), a handle maker (22), and a knife (36). The material is enclosed within the netting by closing an end of the netting (with clip 12 for the first package), placing material within the netting, closing the netting (using clipper 18 for another clip 12 for the second package), creating a loop (28) from the netting (by the use of 22) which moves the material (14) and stretches the netting to

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form a loop, and severing the loop from the netting (using knife 36), and closing the loop to create a handle on the netting enclosing the material. The closing of the loop is done by attaching the loop to the netting by the use of clipper (16) with the loop being "typically" (see col. 3, line 65) attached before the netting is severed by the knife (36).

The May et al. apparatus and method meets all of applicant's claimed subject with the exception of expressly disclosing a product tube, and the net material being severed before the loop is attached to the netting.

The Marsal reference discloses that it is old and well known in the relevant art to use a product tube (as seen in the figures) to assist in loading the material into the netting, and to sever the netting material either before or after the loop is attached to the netting.

It would have been obvious to a person having ordinary skill in the art, at the time applicant's invention was made, to have modified the apparatus and method of May et al. by having provided a product tube in order to assist in loading the material into the netting, and to have severed the netting material before the loop is attached to the netting, as taught by Marsal, since applicant has not disclosed that severing the

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netting before attaching the loop to the netting as opposed to severing the netting after attaching the loop to the netting solves any stated problem and it appears that the invention would perform equally well with the netting being severed either before or after attaching the loop to the netting.

16. Claims 2, 3, 7-9, 11, 12, 15-17 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1, 4, 10, 13 and 21 above, and further in view of Niedecker (US 5,300,344) and Grip et al. (US 6,270,821).

The May et al. apparatus and method, as modified by Marsal above, meets all of applicant's claimed subject matter with the exception of (in the apparatus claims) a means for printing information on a label and a means for attaching the label to the netting, and a scale to measure a weight of the material and transmit the weight to the means for printing, and (in the method claims) inserting a label in the loop when closing the loop, weighing the material and printing a weight of the material on the label, and printing other information on the label.

The Niedecker reference discloses that it is old and well known in the relevant art to provide a means for printing (see col. 2, lines 65-68) information on a label and means for

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attaching (see col. 1, lines 8 and 9) the label to the netting, and a scale (see col. 1, line 19) to measure a weight of the material and transmit the weight to the means for printing (see col. 2, lines 65-68), and the Niedecker reference also discloses that it is old and well known in the relevant art to insert a label when closing the netting (see col. 1, lines 6-23), to weigh the material (col. 1, line 19) and print a weight of the material on the label (col. 1, line 14), and to print other information on the label (col. 1, line 14).

The Grip et al. reference discloses that it is old and well known in the relevant art to affix a pouch having a label thereon to the loop of the netted product with a clip, and with the label having the weight and other information applied thereto as seen in figures 8 and 9.

It would have been obvious to a person having ordinary skill in the art, at the time applicant's invention was made, to have further modified the apparatus and method of May et al. by having provided a means for printing information on a label and means for attaching the label to the netting, and a scale to measure a weight of the material and transmit the weight to the means for printing, and inserting a label in the loop when closing the loop, weighing the material and printing a weight of

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the material on the label, and printing other information on the label, as suggested by the teachings of Niedecker and Grip et al., for the self-evident advantage of providing the consumer with product information for regulatory and marketing reasons -- see col. 1 of Niedecker and col. 6 of Grip et al.

Claims - No Prior Art Rejections

17. Currently no prior art rejections are made with regard to claims 18-20.

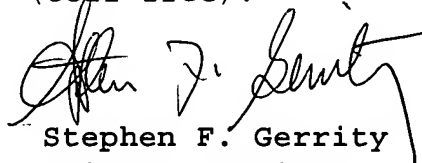
Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed on the attached form (PTO-892) are cited to show machines and methods for enclosing material within wrapping material and for closing the wrapping material. All are cited as being of interest and to show the state of the prior art.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gerrity. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, may be contacted. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Stephen F. Gerrity
Primary Examiner
Art Unit 3721

Examiner's Telephone Number: 703-308-1279
Examiner's Work Schedule: Monday-Friday from 5:30 - 2:00
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Receptionist Telephone Number: 703-308-1148
9 August 2004